



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,769	01/19/2005	Hans Lichtenstein	264451US0PCT	4171
22850	7590	07/11/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KOSLOW, CAROL M	
			ART UNIT 1755	PAPER NUMBER
			NOTIFICATION DATE 07/11/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/521,769

Applicant(s)

LICHTENSTEIN ET AL.

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>2/20/07</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1755

This action is in response to applicants' amendment of 18 May 2007. The amendment to the specification has overcome the objection to the disclosure. The amendments to the claims have overcome the objections to the claims. Applicant's arguments with respect to the rejections have been fully considered but they are not persuasive.

The amendment to the claims filed on 18 May 2007 does not comply with the requirements of 37 CFR 1.121(c) because the status modifiers for claims 1 and 11 are incorrect. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required*. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

Art Unit: 1755

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

The status modifier for claim 1 should be “Previously Presented” since there are no amendments made to this claim and the status modifier to claim 1 should be “new” since it is a new claim.

Claims 2 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 2 teaches the white pigment comprises titania, zinc oxide or zinc sulfide, which means the pigment can contain other materials besides the claimed titania, zinc oxide and zinc sulfide. Page 4 of the specification teaches white pigment is titania, zinc oxide or zinc sulfide. The discrepancy between the claimed definition of the pigment and the definition on page 4 needs to be clarified.

Page 5 teaches using the taught moldings for vehicle bodywork, designer furniture, signage or parts thereof or for light systems. There are no methods for producing for vehicle bodywork, designer furniture, signage or parts thereof or for light systems or the method comprising incorporating the taught moldings into vehicle bodywork, designer furniture, signage, light systems or parts thereof disclosed in the specification. The discrepancy between the claimed process and the uses taught on page 5 needs to be clarified.

Applicants argues there is no discrepancy between the composition of the white pigment given ad claim 2 and that given on page 4 of the specification and the language in claim 2 is appropriate. The Examiner disagrees since the definition of the white pigment on page 4 is narrower than the composition in claim 2 for the reasons given above.

Applicants argue page 4, line 20 to page 5, line 5 supports claim 9. Nowhere in these lines is that any teaching of producing for vehicle bodywork, designer furniture, signage or parts thereof or for light systems nor a method of incorporating the molding into vehicle bodywork, designer furniture, signage or parts thereof or for light systems. This section simply teaches how to produce the moldings and indicates they can have any shape. Thus this section does not overcome the rejection. Page 5, lines 24-35 teaches the uses of the moldings. The teaching that the molding can be used for vehicle bodywork, designer furniture, signage or parts thereof or for light systems does not given any methods of producing vehicle bodywork, designer furniture, signage or parts thereof or for light systems, themselves, nor incorporating the moldings into these articles. Thus this section does not overcome the rejection. The rejections are maintained.

Art Unit: 1755

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is indefinite since there are no actual process steps disclosed for producing vehicle bodywork, designer furniture, signage, light systems or parts thereof. The claimed step of incorporating the molding of claim 1 into these articles does not produce these articles.

Applicants argue page 4, line 20 to page 5, line 5 supports claim 9. Nowhere in these lines is that any teaching of producing for vehicle bodywork, designer furniture, signage or parts thereof or for light systems nor a method of incorporating the molding into vehicle bodywork, designer furniture, signage or parts thereof or for light systems. This section simply teaches how to produce the moldings and indicates they can have any shape. Thus this section does not overcome the rejection. Page 5, lines 24-35 teaches the uses of the moldings. The teaching that the molding can be used for vehicle bodywork, designer furniture, signage or parts thereof or for light systems does not give any methods of producing vehicle bodywork, designer furniture, signage or parts thereof or for light systems, themselves, nor incorporating the moldings into these articles. Thus this section does not overcome the rejection. The rejection is maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06-67612.

The translation of this reference teaches a molding and signs including this molding which must be produced by incorporating the molding in a sign. The taught molding comprises a

Art Unit: 1755

transparent plastic matrix, such as cast polymethyl methacrylate which has a transmittance in the claimed range, a soluble fluorescent dye, color pigment and 0.01-10 wt% of a white pigment of a mixture of TiO_2 and barium sulfate. The weight ratio of TiO_2 to barium sulfate is greater than 0 wt% to less than 100 wt%. Thus the amount of TiO_2 is in the range of greater than 0 wt% to less than 10 wt%. This range overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the taught composition overlaps the claimed composition, one of ordinary skill in the art would expect the taught molding to have a reflectance that overlaps the claimed range, absent any showing to the contrary. The reference suggests the claimed molding and method.

Applicants argue the EP equivalent to this the reference does not teach a mixture of barium sulfate and titania. That is immaterial since the rejection is not over the EP equivalent, but over JP 6-67612 and paragraph [0018] of this reference teaches mixtures of the listed white pigments and indicates it is advantageous to be titania and barium sulfate. Therefore this argument is not convincing and the rejection is maintained.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,375,864.

This reference teaches a molding comprising a transparent plastic matrix, such as polycarbonate or polyvinyl chloride; a soluble fluorescent dye; a phosphorescent colorant; 0.001-2 wt% of a whitening pigment, such as ZnO , ZnS or TiO_2 and 0.001-20 wt% of a filler, such as calcium carbonate, talc (a magnesium silicate) and china clay (an aluminum silicate). This range

Art Unit: 1755

overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the taught composition overlaps the claimed composition, one of ordinary skill in the art would expect the taught molding to have a reflectance that overlaps the claimed range, absent any showing to the contrary. Column 4, lines 33-45 teach incorporating this molding into signs, vehicle bodywork and lighting system. The reference suggests the claimed molding and method.

The fact the reference does have an example showing the taught composition comprising a transparent plastic matrix, such as polycarbonate or polyvinyl chloride; a soluble fluorescent dye; a phosphorescent colorant; 0.001-2 wt% of a whitening pigment, such as ZnO, ZnS or TiO₂ and 0.001-20 wt% of a filler, such as calcium carbonate, talc (a magnesium silicate) and china clay (an aluminum silicate) does not overcome the rejection since a reference is not limited to its examples, but is good for all it teaches. The rejection is maintained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1755

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
July 5, 2007


C. Melissa Koslow
Primary Examiner
Tech. Center 1700